



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|-------------|----------------------|---------------------|
|-----------------|-------------|----------------------|---------------------|

09/146,835 09/03/98 ITO

M MAT-6280

EXAMINER

WALLERSON, M

ART UNIT

PAPER NUMBER

2622

DATE MAILED:

10/23/01

LAWRENCE E ASHERY  
RATNER & PRESTIA  
SUITE 301 ONE WESTLAKES BERWYN  
P O BOX 980  
VALLEY FORGE PA 19482-0980

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/146,835

Applicant(s)

Ito et al

Examiner

Mark Wallerson

Art Unit

2622



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Aug 6, 2001
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above, claim(s) 10-22 and 24-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☒ All b) ☐ Some\* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

Art Unit: 2622

### **Part III DETAILED ACTION**

#### ***Notice to Applicant(s)***

1. This action is responsive to the following communications: amendment filed on 8/6/2001.
2. This application has been reconsidered. Claims 1-33 are pending.

#### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-9 and 23 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

(1) There is no disclosure in the original specification of "an addressable memory".

(2) There is no disclosure in the original specification that the processing method is selected after the picture information is captured.

If Applicant disagrees with the statements above, Applicant is requested to SPECIFICALLY point out support for the limitations above.

Art Unit: 2622

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Saito (U. S. 5,153,729).

With respect to claims 1 and 23, Saito discloses a digital camera comprising an addressable memory (which reads on memory card 12) (the abstract, lines 1-2 and column 3, lines 38-56), which is separable from the camera (column 3, lines 38-43); picture capturing means (10) for capturing picture information corresponding to an image and for storing picture information in the memory (the abstract, lines 1-7 and column 3, lines 38-43); a control image processor (22) for storing in the memory a processing method for indicating how information is to be processed (control data), the processing method selected after the picture information is captured, and remaining in the memory (column 4, lines 37-51).

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

Art Unit: 2622

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

8. Claims 1, 2, 3, 4, 5, 6, and 23 are rejected under 35 U.S.C. 102(e) as being anticipated by Lourette et. al. (hereinafter referred to as Lourette) (U. S. 5,978,016).

With respect to claims 1 and 23, Lourette discloses a digital camera comprising an addressable memory (which reads on a memory card) (column 10, lines 10-19), which is separable from the camera (column 10, lines 10-19); picture capturing means (16) for capturing picture information corresponding to an image and for storing picture information in the memory (column 10, lines 10-19 and column 13, lines 15-31); a control image processor (68) for storing in the memory a processing method for indicating how information is to be processed (which reads on an image information file), the processing method selected after the picture information is captured, and remaining in the memory (column 14, lines 38-43 and column 17, line 35 to column 18, line 10).

With regard to claims 2 and 4, Lourette discloses the picture selecting means is for selecting the picture to be transmitted and printed (in the photofinisher), and the stored information relates to the transmission and printing of the picture (column 17, lines 35-56).

With respect to claim 3, Lourette discloses the picture selecting means is for selecting the picture to be displayed, and the stored information relates to the display of the picture (column 15, lines 15-64).

Art Unit: 2622

With regard to claim 5, Lourette discloses the processing control information storage means stores a processing instruction string (which reads on information specific to the digital images) (column 5, lines 63-66).

With respect to claim 6, Lourette discloses selecting a picture corresponding to the order person and information corresponding to the order person (column 17, lines 4-56 and column 19, lines 1-15).

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 7, 8, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lourette in view of Petruchik et. al. (hereinafter referred to as Petruchik) (U. S. 5,619,738).

With respect to claims 7, 8, and 9, Lourette differs from claims 7, 8, and 9 in that he does not clearly disclose storing information about a rotation angle of the picture. Petruchik discloses means for storing print orientation information (column 5, lines 58-67). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Lourette to store information about a rotation angle of the picture. It would have been obvious to

Art Unit: 2622

one of ordinary skill in the art at the time of the invention to have modified Lourette by the teaching of Petruchik in order to more easily define the exposure.

***Response to Arguments***

11. Applicant's arguments filed 8//6/2001 have been fully considered but they are not persuasive.

Applicant submits that the cited prior art does not disclose “a control information processor for storing in said memory a processing method for indicating how said picture information is to be processed, said processing method selected after said picture information is captured”, and the “said processing method remaining in said memory after said memory is separated from said camera”. The Examiner respectfully disagrees.

Saito clearly discloses that the control information (or processing method) is stored in the memory after the picture is captured (column 4, line 52 to column 5, line 50). Additionally, since the memory cartridge would be used in a playback apparatus, and the playback apparatus uses the control information (picture quality information) to process the picture (column 4, lines 48-51), it is obvious that the information remains in the memory after the memory is removed from the camera.

Lourette the control information is stored in the memory after the picture is captured (column 17, line 35 to column 18, line 10), and that the information remains in the memory after the memory is removed from the camera (column 18, lines 6-10).

Art Unit: 2622

***Election/Restriction***

12. This application contains claims 10-22 and 24-33 drawn to an invention nonelected without traverse in Paper No. 9. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

***Conclusion***

13. All claims are rejected.

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Wallerson whose telephone number is (703) 305-8581.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Any response to this action should be mailed to:



Art Unit: 2622

Commissioner of Patents and Trademarks  
Washington, DC 20231

or faxed to:

(703) 872-9314 (for formal communications intended for entry)

(for informal or draft communications, such as proposed amendments to be discussed at  
an interview; please label such communications "PROPOSED" or "DRAFT")

or hand-carried to:

Crystal Park Two  
2121 Crystal Drive  
Arlington, VA.  
Sixth Floor (Receptionist)

  
**MARK WALLERSON**  
**PATENT EXAMINER**

Mark Wallerson